

REMARKSThe Restriction Requirement

Applicants maintain their traversal of the restriction requirement for the reasons previously stated.

It appears from the Office Action that it is now recognized that claims 14-16 do require the particulars of the invention of Group I, i.e., claims 14-16 specifically recite that a compound of claim 1, composition of claim 11 or polymer of claim 12, respectively, are required in the polarizer, etc., article. However, the statement in the Office Action that "the presence of Group I is absolutely not required as one of the polarizer elements" is not understood. In claim 14, the presence of a compound of Group I, i.e., claim 1, is absolutely required because the claim specifically recites that the polarizer, etc., article contain a compound of claim 1. Thus, it is re-iterated that the restricted claims are dependent upon the claims of Group I and, by definition as dependent claims, certainly do require the particulars of those claims.

This reason alone should be sufficient to withdraw the restriction. Because the restricted groups are related to the elected group as combination-subcombination – as admitted in the Office Action – the standard for requiring restriction is as follows; see M.P.E.P. § 806.05(c), emphasis added:

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e. separate classification, status, or field of search. See MPEP § 808.02. If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

well versed in the nature of polymerizable groups, mesogenic groups and chiral or achiral alkyl groups in this art and how to provide compounds containing them.

Again, the primary basis alleged for supporting the rejection is that the claim scope is considered very broad. This is not a proper basis for rejection under 35 U.S.C. § 112, first paragraph. The breadth of the claim should be limited only by the prior art, of which none has been applied against the instant claims. Further, it is alleged that there are not working examples for every compound within the claimed scope. Again, the law is quite clear that examples of every embodiment are not required; see MPEP § 2164.03 – supported by numerous court decisions. Applicants' disclosure complies with the statement in the MPEP that:

“For a claimed genus, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if one skilled in the art (in view of level of skill, state of the art and the information in the specification) would expect the claimed genus could be used in that manner without undue experimentation.”

As for enablement for using the compounds, analogous reasoning applies and the specification provides adequate description of the use of the whole scope of claimed compounds. See, e.g., page 4, line 5 to page 5, line 22, and page 7, lines 6-24, of the specification.

Based on the specification and the knowledge of one of ordinary skill in the art, one of ordinary skill in the art could practice the entire scope of the instant claimed invention by carrying out only routine, i.e., not undue, experimentation. It may be a typo, but the Office Action appears to admit that “the skilled artisan can practice the instant invention without undue experimentation.” (Emphasis original.) If this is true, then the claims are clearly enabled. The law does not require that the disclosure provide examples of every type of compound such that no experimentation would be required. The law admits that the

disclosure can be enabling even when one has to carry out some experimentation to arrive at the claimed invention. It only requires that such experimentation not be undue. It is not undue here and no reasoning has been provided as to why it would be undue.

For all of the above reasons, it is urged that the rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. The term "a chiral or achiral alkyl radical" is not indefinite. The spatial arrangements, i.e., including S or R configuration radicals, are not relevant to the inquiry, as implied by the argument on page 5, first full paragraph, of the Office Action. The claims recite nothing about R or S configuration. The chiral term clearly encompasses alkyl radicals which are chiral in either of these configurations since it is not limited to any particular chiral configuration. One of ordinary skill in the art (or in any chemical art) knows well what defines a chiral or achiral radical. Particularly when the term is applied just to alkyl radicals, the scope is not overly broad and how to distinguish between alkyl radicals which are chiral or achiral is clear to the ordinarily skilled chemist. Thus, the term is not indefinite and the rejection should be withdrawn.

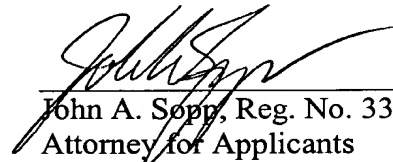
The Indication of Allowability

The indication of allowability of the elected species over the prior art is respectfully acknowledged. Because it is believed that the claims are otherwise allowable, in view of the above arguments, the search and examination should be extended to additional species and, should such species be found allowable, to the entire claimed scope.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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